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In re Application of
Frank-Martin Wille et al.
Application No. 10/593,453
Filed: September 19, 2006
For: MOTOR VEHICLE CONTROL SYSTEM

: DECISION ON PETITION
: TO WITHDRAW FINALITY
: OF OFFICE ACTION
: UNDER 37 CFR 1.181

This is a decision on Applicant's petition under 37 CFR 1.181, filed August 25, 2009, to withdraw the finality of the Final Office action mailed May 26, 2009.

The petition is **DENIED**.

Applicant alleges that the final rejection mailed August 12, 2003 was premature because the amendment filed on January 29, 2009 only amended the claims to remedy certain informalities and arguing the lack of anticipation of the prior art reference to Inaba et al. (US 2002/0015035).

A review of the file reveals that a non-final Office action dated October 30, 2008 included 112, 2nd paragraph rejections and 102(b) rejection. Applicant responded with an amendment dated January 29, 2009 that amended the claims to overcome indefiniteness cited by examiner in the 112, 2nd paragraph rejections. Subsequently, a final Office action was issued on May 26, 2009 in which the examiner withdrew the 112, 2nd rejections and maintained the initial 102(b) rejection on Inaba et al., but also raised a new 102(b) rejection using the prior art reference to Obradovich (US 6,275,231).

Applicant's response to the non-final Office action dated January 29, 2009 substantially amended the claims to overcome 112, 2nd paragraph rejections. The rejections [112, 2nd] were withdrawn by the examiner. However, in clarifying the claim language, the amendment presented a change in scope of the claims by adding new limitations such as "*is accessible from*" in claims 1 and 2, "*upon inquiry*" in claim 2, "*responsive to*" in claim 4, "*selected*" in claims 5-7 and 15-16, "*including means for*" in claim 11, just to name a few, as well as deleting claim languages in claims 1, 2, 4-8, 10-16. The changes made in the claims necessitated the examiner's new art rejection. Even though the previous rejection was maintained by the examiner, it is office policy to provide applicant with a complete and thorough examination of the claims when presented. As such, it is proper for the examiner to present a new ground of rejection that was necessitated by applicant's amendment filed on January 29, 2009.

In light of 37 CFR 706.07(a) which states that "under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)", the finality of the Office action mailed on May 26, 2009 was proper due to the fact

that the amendment filed on January 29, 2009 changed the scope of the claims which necessitated a new ground of rejection.

For the foregoing reasons, the petition for withdrawal of the finality is **DENIED**.

Any questions or comments with respect to the decision should be forwarded to Supervisory Patent Examiner, Jack Keith at (571) 272-6878.

Katherine Matecki

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jwk/lm: 11/16/09

LM